APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,636	10/26/2001	Robert Brondijk	206	1426

31665	7590	07/06/2005

PATENT DEPARTMENT
MACROVISION CORPORATION
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EXAMINER
PERUNGAVOOR, VENKATANARAY

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/014,636	BRONDIJK ET AL.
	Examiner	Art Unit	
	Venkatanarayanan Perungavoor	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-64 and 66-80* is/are pending in the application.

    4a) Of the above claim(s) *2 and 65* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-65 and 67-80* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The claim objection has been withdrawn in response to correct numbering of

    claims.

2. The Applicant's arguments regarding claim 1 filed on 6/20/2005 are not

    persuasive. As Ogino et al(hereinafter Ogino) in U.S. Patent 6,571,220 B1

    discloses functionality for copy-once and copy-no-more searching(see Fig.14

    item S305) and not providing the material if copy-no-more is found(see Col 10 Ln

    1-6)and remarking the copy-no-more if copy-once is found(see Col 5 Ln 39-47).

3. The Applicant's arguments regarding claim 10 is not persuasive. As Ogino

    suggests of an secure connection between the output(recording unit) and

    processing unit see Col 14 Ln 53-60. The Applicant is further reminded, *In*

    Syntex (U.S.A.) LLC V. Apotex Inc., 74 USPQ2d 1823 (CA FC 2005), "Prior art

    reference teaches away from claimed invention if it suggests that developments

    flowing from its disclosures are unlikely to produce objective of invention, and

    what reference teaches person of ordinary skill in art is not limited to what

    reference specifically 'talks about' or what is specifically 'mentioned' or 'written' in

    reference;..."

4. The Applicant's arguments regarding claim 12 is not persuasive. As Ogino does discloses the checking for copy-once indication and establishing a secure channel between recording unit and processing unit afterward see Col 13 Ln 15-34 & Col 14 Ln 24-41& Col 7 Ln 49-51.

5. The Applicant's arguments regarding claim 13 is not persuasive. As Ogino does discloses a recording unit and a control unit(preprocessing unit) capable of detecting watermarks independent of each other see Col 13 Ln 15-34 & Col 6 Ln 39-51.

6. The Applicant's arguments regarding claim 15, 16, 17 and 19 are not persuasive. As Ogino discloses an IEEE 1394[1] interface which includes an computer, as the preprocessing unit is being included in computer's expansion board is suggested see Col 10 Ln 8-27. The video capture board is also suggested by Ogino see Col 7 Ln 38-46. And further Ogino also suggests of an network board and network appliance see Col 7 Ln 26-37, as Ogino discloses broadcasting and picking channels thus functional doing the same thing as a network appliance and board. And the Applicant reminded, In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow... The reason is simply that during patent prosecution when claims can be amended,

ambiguities should be recognized, scope and breadth of language explored, and

clarification imposed... An essential purpose of patent examination is to fashion

claims that are precise, clear, correct and unambiguous. Only in this way can

uncertainties of claim scope be removed, as much as possible, during the

administrative process".

7. Applicant's arguments regarding claim 22 and 42 is not persuasive. As Ogino

discloses the transmitting of detection of copy-once back to sender see Fig. 10

item 100a & Col 16 Ln 47-62.

8. Applicant's arguments regarding claim 64 is not persuasive. As Ogino discloses

the passing information back to preprocessing unit over an secure channel Col

13 Ln 15-34 & Col 14 Ln 24-41 & Col 7 Ln 49-51.

9. For citations of 35 U.S.C §102(e) and 35 U.S.C § 103 please refer to previous

office action.

Response to Amendments

Claim Rejections - 35 USC § 102

10. Claim 1-2, 4-7, 9-34, 36-39, 41-54, 56-64,66-80 rejected under 35 U.S.C. 102(e)

as being anticipated by U.S. Patent 6,571 ,220 B1 to Ogino et al.

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[1] See http://www.vxm.com/21R.49.html for further explanation on IEEE 1394 compability with personal

11. A system for providing protected copying of material, comprising: a

preprocessing unit having an output and capable of providing copy-once

functionality on a material before providing said material on said output- wherein

said copy-once functionality includes searching for a copy-once indication and a

copy-no- more indication in said material not providing said material on said

preprocessing unit output if said copy-no-more indication is found and remarking

said material with said copy-no-more indication before providing said material on-

said preprocessing unit output if said copy-once indication is found and said

copy-no-more indication is not found(see Col 10 Ln 1-6 & Col 5 Ln 39-47 &

Fig.14 item S305) and a recording unit coupled to said preprocessing unit output

and capable of searching for a copy-never indication in said material provided on

said preprocessing unit output and copying said material unless said copy-never

indication is found but lacking capability to remark said material with a copy-no-

more indication(Col 6 Ln 39-51).

12. Regarding Claim 2, Ogino discloses copy-never watermark is embedded within

the material see Column 6 Line 23-33.

13. Regarding Claim 4 and 5, Ogino discloses the copy-one and copy-no-more

watermark embedded within the material see Column 6 Line 8-15.

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computer.

14. Regarding Claim 6 and 7, Ogino discloses the secure channel and checking of watermark information and also of key exchange see Column 6 Line 58-67.

15. Regarding Claim 9, Ogino discloses the searching for watermarks that represent "copy-once" see Column 12 Line 1 1-29.

16. Regarding Claim 10 and 12, Ogino discloses the step of finding the copy-once watermark after establishing secure channel see Col 14 Line 53-60.

17. Regarding Claim 11, Ogino disclose the step establishing secure connection before finding watermarks see Column 6 Line 52-64.

18. Regarding Claim 13, Ogino discloses the preprocessing unit acting as though it had found the copy-once indication see Column 6 Line 39-51 .

19. Regarding Claim 14, Ogino disclose the audio-visual content see Col 8 Line 29-40.

20. Regarding Claim 15,16, 17 and 18, The "preprocessing unit personal computer is included on an expansion board of a personal computer" is met by Ogino et al. Col 15 Line 53-65.

21. Regarding Claim 19, The "network appliance coupled to a recording unit" is met

by Ogino et al. see Column 14 Line 57-60.

22. Regarding Claim 20, The "preprocessing unit is included in a set-top box coupled

to said recording unit" is disclosed by Ogino et al. see Column 7 Line 24-37.

23. Regarding Claim 21, Ogino disclose DVD recordable drive see Column 6 Line

15-21.

24. Regarding Claim 22, A method implemented in a recording unit for providing

protected copying of material, comprising: detecting if a copy-never or copy-once

indication is provided with a material(Col 6 Line 8-15) if said copy-never

indication is detected, then not allowing copying of said material(Col 6 Line 45-

51) if neither said copy-never nor said copy-once indication is detected, then

allowing copying of said material(Col 12 Line 11-18) and if said copy-once

indication is detected, then transmitting information of said detection of said

copy-once indication back to a sender of said material provided a secure channel

is established with said sender, otherwise not allowing copying of said

material(Col 12 Line 19-29).

25. Claim 23 is rejected under the same rationale as Claim 14 above.

26. Claim 24 is rejected under the same rationale as Claim 2 above.

27. Claim 25 is rejected under the same rationale as Claim 4 above.

28. Claim 26 is rejected under the same rationale as Claim 21 above.

29. Claim 27 is rejected under the same rationale as Claim 15 above.

30. Claim 28 is rejected under the same rationale as Claim 16 above.

31. Claim 29 is rejected under the same rationale as Claim 17 above.

32. Claim 30 is rejected under the same rationale as Claim 19 above.

33. Claim 31 is rejected under the same rationale as Claim 20 above.

34. Regarding Claim 32, The "method according to claim 22, wherein said transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material, comprises: if said copy-never indication is not said copy-once indication is detected, then detected and a secure channel already established with said sender of said material, then transmitting information of said detection of said copy-once indication back to said sender of said material, and said secure channel is not already established with said sender of said material, then not allowing copying of said material" is met by Ogino et al. see Col 10 Line 53-64 & Column 9 Line 54-58.

35. Regarding Claim 33, The "method according to claim 22, wherein said transmitting information of said detection of said copy-once indication back to a

sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material, comprises'. "if said copy-never indication is not detected and said copy-once indication is detected, then establishing a secure channel with said sender of said material', if said secure channel cannot be established, then not allowing copying of said material', and if said secure channel is established, then transmitting information of said detection of said copy-once indication back to said sender of said material" is met by Ogino et al. see Col 10 Line 53-64 & Column 9 Line 54-58.

36. Claim 34 is rejected under the same rationale as Claim 7 above.

37. Regarding Claim 36, 37, and 38, Ogino et al. discloses transmitting information only when allowed based on watermarks and done thorough an secure channel see Col 10 Line 53-64 & Column 9 Line 54-58.

38. Claim 39 is rejected under the same rationale as Claim 7 above.

39. Claim 41 is rejected under the same rationale as Claim 5 above.

40. Regarding Claim 42, A recording unit for providing protected copying of material, comprising: an input channel receiving a material for copying(Col 10 Line 1 1-18), a primary detector coupled to said input channel to detect a copy-never indication

and a copy-once indication are provided with said material(Col 9 Line 66-Col 10

Line 6), and compliance logic coupled to said primary detector and configured

such that if said copy-never indication is detected, then preventing said material

from being copied, and if neither said copy-never nor said copy-once indication is

detected, then allowing said material to be copied(Col 10 Line 47-641.

41. Claim 43 is rejected under the same rationale as Claim 14 above.

42. Claim 44 is rejected under the same rationale as Claim 2 above.

43. Claim 45 is rejected under the same rationale as Claim 4 above.

44. Claim 46 is rejected under the same rationale as Claim 21 above.

45. Claim 47 is rejected under the same rationale as Claim 15 above.

46. Claim 48 is rejected under the same rationale as Claim 16 above.

47. Claim 49 is rejected under the same rationale as Claim 17 above.

48. Claim 50 is rejected under the same rationale as Claim 19 above.

49. Claim 51 is rejected under the same rationale as Claim 20 above.

50. Claim 52 and 53 are rejected under the same rationale as Claim 32 and 33,

respectively.

51. Claim 54 is rejected under the same rationale as Claim 7 above.

52. Claim 60 is rejected under the same rationale as Claim 5 above.

53. Regarding Claim 61,62 and 63 compliance logic being processor, state machine and logic circuit are substantially taught by Ogino et al. see Column 12 Line 42-48 & Column 11 Line 36-43.

54. Regarding Claim 64, A system for providing protected copying of material comprising: a preprocessing unit having at least one input channel for receiving material and an output channel for providing an output wherein said material is provided as said output neither a copy-never indication nor a copy-once indication is detected as being provided with said material, said material is not provided as said output if either said copy-never indication is detected as being provided or said copy-once indication and a copy-no-more indication are both detected as being provide with said material, and an encrypted version of said material including said copy-no-more indication is provided as said output and said output channel is configured to be a secure channel if said copy-once indication is detected and said copy-no-more indication is not detected prior to said inclusion with said material (Abstract & Col 11 Line 65-Col 12 Line 10); and a recording unit coupled to said output channel of said preprocessing unit and including a primary detector to detect if a copy-never indication and a copy-once indication are provided with said preprocessing unit's output (Col 12 Line 42-48); and compliance logic coupled to said primary detector and configured such that if said copy-never indication is detected then not allowing said preprocessing unit's output to be copied and if neither said copy-never nor said copy-once indication

is detected then allowing said preprocessing unit's output to be copied and if said

copy-once indication is detected- then establishing a secure channel-with said

preprocessing unit and passing information of said detection of said copy-once

indication back to said preprocessing unit over said secure channel(Col 13 Ln

15-34 & Col 14 Ln 24-41 & Col 7 Ln 49-51).

55. Regarding Claim 66, The "preprocessing unit receives said information of said

detection of said copy-once indication passed back by said recording unit, and

provides said encrypted version of said material including said copy-no-more

indication as said output over said secure channel" is met by Ogino et al. see

Column 12 Line 19-33.

56. Regarding Claim 67, The "recording unit further includes a secondary detector to

detect if a copy-no-more indication is provided with said preprocessing unit

output, and said compliance logic is further configured such that if said copy-

once indication is detected and said copy-no-more indication is not detected,

then passing information of said detection of said copy-once indication back to

said preprocessing unit over said secure channel if said secure channel has

already been established" is met by Ogino et al. see Column 6 Line 8-51 .

57. Regarding Claim 68, The "recording unit further includes a secondary detector to

detect if a copy-no-more indication is provided with said preprocessing unit

output, and said compliance logic is further configured such that if said copy-

once indication is detected and said copy-no-more indication is not detected,

then establishing a secure channel with said preprocessing unit and passing

information of said detection of said copy- once indication back to said

preprocessing unit over said secure channel" is met by Ogino et al. see Column

6 Line 39-64.

58. Claim 69 is rejected under the same rationale as Claim 14 above.

59. Claim 70 is rejected under the same rationale as Claim 2 above.

60. Claim 71 is rejected under the same rationale as Claim 4 above.

61. Claim 72 is rejected under the same rationale as Claim 5 above.

62. Claim 73 is rejected under the same rationale as Claim 15 above.

63. Claim 74 is rejected under the same rationale as Claim 19 above.

64. Claim 75 is rejected under the same rationale as Claim 20 above.

65. Claim 76 is rejected under the same rationale as Claim 21 above.

66. Claim 77 is rejected under the same rationale as Claim 7 above.

67. Claim 78, 79, and 80 is rejected under the same rationale as Claim 61, 62 and 63

above respectively.

Claim Rejections - 35 USC § 103

68. Claim 8, 35,40,55 is rejected under 35 U.S.C. 103(a) as being unpatentable over

69. U S Patent 6571220 B1 to Ogino et al. in view of NPL to Stalling

70. Ogino does not disclose the key exchange being done via Diffie-Hellman key exchange. However, Stallings discloses the use of Diffie-Hellman key exchange for use between two communicating devices see pp 296 paragraph 2-3. It would be obvious to one having ordinary skill in the art at the time of the invention to include Diffie-Hellman in the invention of Ogino in order to use an secure key exchange as taught in Stallings see pp 296 paragraph 2-3.

71. Claim 35 is rejected under the same rationale as Claim 8 above.

72. Claim 40 is rejected under the same rationale as Claim 8 above.

73. Claim 55 is rejected under the same rationale as Claim 8 above.

Conclusion

74. The following patents were cited in a previous PR-892 to further show the state of art in general:

U.S. Patent 6,633,723 B1 to Kuroda et al.

U.S. Patent 6,707, 774 B1 to Kuroda et al.

U.S. Patent 6320829 B1 to Matsumoto et al.

75. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkatanarayanan Perungavoor whose

telephone number is 571-272-7213. The examiner can normally be reached on

8-4:30. If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The

fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

76. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Venkatanarayanan Perungavoor
Examiner
Art Unit 2132

ν/P
6/30/2005

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